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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,555	07/10/2001	Pierre Hirsbrunner	81358-200	7190
28765	7590	02/25/2004	EXAMINER	
WINSTON & STRAWN PATENT DEPARTMENT 1400 L STREET, N.W. WASHINGTON, DC 20005-3502			KOSLOW, CAROL M	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/902,555	HIRSBRUNNER ET AL.
	Examiner	Art Unit
	C. Melissa Koslow	1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 December 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 20-26 is/are allowed.
- 6) Claim(s) 1-5, 18, 19 and 27-30 is/are rejected.
- 7) Claim(s) 6 and 17 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1 December 2003 has been entered.

The indicated allowability of claims 27-30 is withdrawn due to applicants' amendments to the claims and upon further consideration of applicants' arguments.

Claims 19 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no teaching or suggestion in the specification or in the art that agricultural soil comprises gravel, tree bark, sawdust or other solid porous materials. Applicants need to show these compounds are conventional part of agricultural soils.

Claims 19 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite since the "other solid porous materials" present in agricultural soil is not defined in the specification or in the art. Thus one of ordinary skill in the art cannot determine what materials applicants intend to encompass by this phrase.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 18, 19 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown.

This reference teaches a substrate treating solution for imparting hydrophobicity to the substrate consisting of an aqueous solution of an alkali metal silicate and an alkali metal alkyl silicate. Run numbers 7-9 teach aqueous compositions containing 1.25 wt% sodium silicate and 0.25 wt% sodium methyl silicate; 2.5 wt% sodium silicate and 0.5 wt% sodium methyl silicate and 5 wt% sodium silicate and 1 wt% sodium methyl silicate. The composition falls within the claimed range. Column 5, lines 40-55 teach the composition contains 0.1-10 wt% silicate and 0.1-30 wt% silicate. These amounts overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Since the weight percentages overlap, one of ordinary skill in the art would expect the molar ratios to also overlap, absent any showing to the contrary. The reference suggests the claimed composition. Since the claimed and taught composition overlap, one of ordinary skill in the art would expect the taught composition to have the claimed property of claims 1, 19 and 28 in the overlapping range and to have a composition that overlaps that of claim 18.

In response to applicant's arguments, the recitation "agricultural soil treating agent" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or

the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicants argue the claimed composition is used for treating soil to retain water to assist in crop growth. While the specification teaches the composition can have this use, it also teaches the composition is used to render substrates, such as masonry, hydrophobic. There does not appear to be any compositional difference between the claimed agricultural soil treating agent and the composition when it is used to render substrates, such as masonry, hydrophobic. The rejection is maintained.

Claims 1-4, 18, 19 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al.

This reference teaches a soil treating agent for imparting hydrophobicity to the substrate consisting of an aqueous solution of an alkali metal silicate and an alkali metal alkyl silconate. Column 2, lines 31-32 that alkali metal silicate and alkali metal siliconate can be used in any weight ratio, which means that any molar ratio can be used. These amounts overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The alkali metal silicate is preferably sodium or potassium orthosilicate and the alkali metal siliconate is preferably sodium or potassium methyl silconate. The reference suggests the claimed composition. Since the claimed and taught composition overlap, one of ordinary skill in the art would expect the taught composition to have the claimed

property of claims 1, 19 and 28 in the overlapping range and to have a composition that overlaps that of claim 18.

Claims 20-26 are allowable over the cited art of record.

Claims 6 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims are allowable for the reasons given in the previous office actions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (571) 272-1362.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
February 19, 2004

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C. Melissa Koslow
Primary Examiner
Tech. Center 1700